

### **REMARKS**

Favorable reconsideration of this application as presently amended is respectfully requested. Claims 2-4, 7-11 and 45-53 are pending. In this Amendment, claims 1, 5-6, 12-14, 19-20, 28-30, 35-36 and 42-44 are canceled, claims 2, 5, 6, 7, 8, 9 and 10 are amended, and 45-53 are added. No new matter is added. Please note that all references below to paragraphs of the specification of the present application are to the paragraphs in U.S. Published Application No. 2004-0031314.

Support for the amendment to claim 4 is found in the specification in Table 11 of paragraph [0129], as well as elsewhere in the originally filed specification, drawings and claims. Support for new claim 45 is found in the specification at paragraphs [0054] and [0056], as well as elsewhere in the originally filed specification, drawings and claims. Support for new claim 46 is found in the specification at paragraphs [0054], [0055] and [0092], as well as elsewhere in the originally filed specification, drawings and claims. Support for new claims 47-53 is found in the specification in Table 11 of paragraph [0129], as well as elsewhere in the originally filed specification, drawings and claims.

Claims 2-4, 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over French Patent No. 2,645,622 (French '622). This rejection is respectfully traversed with respect to the claims as currently presented.

Claim 2 as currently presented claims a composition comprising hydrogen and an odorant, wherein the odorant is a selenium compound. However, French '622 does not teach or suggest the use of a selenium compound. In fact, the English Abstract of French '622, French '622 only describes the use of mercaptan and thiophane odorants which are both sulfur compounds. Furthermore, as stated by the Examiner at page 4 of the July 24, 2004 Restriction Requirement, selenium compounds are a "patentably distinct species" from sulfur compounds. Therefore, since, as the Examiner has previously admitted, selenium compounds are *patentably distinct from sulfur compounds*, it would *not be obvious* for a person of ordinary skill in the art to employ a selenium compound in place of the sulfur compounds of French '622 and claim 2 is patentable over French '622.

In addition, the Office Action cites no reference showing that selenium compounds

are recognized as be a substitute as an odorant for any purpose, much less for use with hydrogen. Also, the Office Action has not identified any reference that teaches or suggests criteria for choosing an odorant to be used in the place of the mercaptan odorant of French '622. Therefore, the Office Action appears to argue that it would be "obvious to try" to substitute selenium compounds for the sulfur compounds of French '622. However, as stated in *In re Deuel*, 34 USPQ2d 1210, 1216 (Fed. Cir. 1995), "'Obvious to try' has long been held not to constitute obviousness. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988)." Therefore, claim 2 is patentable over French '622, because claim 2 has been rejected based on an improper "obvious to try" standard.

Claims 3, 4, 8 and 9 and new claims 45-53 depend from claim 2, and, accordingly, include all of the patentable features of claim 2 as well as other patentable features. Therefore, claims 3, 4, 8 and 9 and new claims 45-53 are patentable over French '622 for at least the reasons discussed above with respect to claim 2.

Claims 1, 7, 10 and 11 are rejected under 35 U.S.C. § 102(b) as being unpatentable over French Patent No. 2,645,622 (French '622). This rejection is respectfully traversed with respect to the claims as currently presented.

Claims 7, 10 and 11 depend from claim 2, either directly or indirectly, and, accordingly, include all of the patentable features of claim 2 as well as other patentable features. Therefore, claims 7, 10 and 11 are patentable over French '622 for at least the reasons discussed above with respect to claim 2.

With respect to claim 1, this rejection has been rendered moot by the cancellation of claim 1.

Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,699,547 to Cortright *et al.* (Cortright) This rejection has been rendered moot by the cancellation of claim 1.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,517,171 to Ratcliffe *et al.* (Ratcliffe) This rejection has been rendered moot by the

cancellation of claim 1.

Claims 7-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,699,547 to Cortright *et al.* (Cortright). This rejection is respectfully traversed with respect to the claims as currently presented.

Claim 2 as currently presented claims a composition comprising hydrogen and an odorant, wherein the odorant is a selenium compound. However, Cortright does not teach or suggest the use of a selenium compound. Therefore, Cortright cannot teach nor suggest the composition of claim 2, and claim 2 is patentable over Cortright.

Claims 7-10 and new claims 45-53 depend from claim 2, and, accordingly, include all of the patentable features of claim 2 as well as other patentable features. Therefore, claims 7-10 and new claims 45-53 are patentable over Cortright for at least the reasons discussed above with respect to claim 2.

Claims 1, 10 and 11 are rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,497,855 to Wachs (Wachs). This rejection is respectfully traversed with respect to the claims as currently presented.

Claim 2 as currently presented claims a composition comprising hydrogen and an odorant, wherein the odorant is a selenium compound. However, Wachs does not teach or suggest the use of a selenium compound. Therefore, Wachs cannot teach nor suggest the composition of claim 2, and claim 2 is patentable over Wachs.

Claims 10 and 11 and new claims 45-53 depend from claim 2, either directly or indirectly, and, accordingly, include all of the patentable features of claim 2 as well as other patentable features. Therefore, claims 10 and 11 and new claims 45-53 are patentable over Wachs for at least the reasons discussed above with respect to claim 2.

With respect to claim 1, this rejection has been rendered moot by the cancellation of claim 1.

Claims 7-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,497,855 to Wachs (Wachs). This rejection is respectfully traversed with respect to the claims as currently presented.

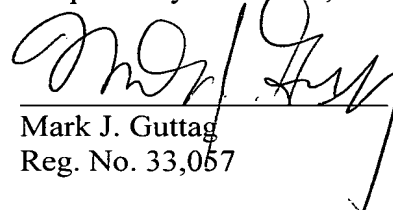
Claims 7-9 depend from claim 2, and, accordingly, include all of the patentable features of claim 2 as well as other patentable features. Therefore, claims 7-9 are patentable over Wachs for at least the reasons discussed above with respect to claim 2.

In addition, with respect to claims 2-4, these claims have been rejected on the basis of facts within the personal knowledge of the Examiner. The Examiner has stated that it would be obvious to employ a selenium compound in place of the mercaptan described in French '622. However, the Examiner has cited no reference that describes the substitution of a selenium compound for a mercaptan for any purpose, much less for use as an odorant. Accordingly, under 37 C.F.R. § 1.104(d)(2) the Applicants hereby request that the Examiner provide an affidavit supporting the Examiner's assertion used as a basis for this rejection.

If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Mark J. Guttag at 703-591-2664, Ext. 2006.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,



Mark J. Guttag  
Reg. No. 33,057

**JAGTIANI + GUTTAG**  
Democracy Square Business Center  
10363-A Democracy Lane  
Fairfax, Virginia 22030  
703-591-2664

January 21, 2005